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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/759,946

01/16/2004

Andreas Schafer

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06/28/2006

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,946

Applicant(s)

SCHAFFER ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/16/04, 11/16/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 6, 15, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "markedly", "preferably", and "finely" in claims 5 and 15 are relative terms which render the claims indefinite. The terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The remaining claims are rejected as they are based on indefinite base claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7-15, 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Jeanne et al. (US 5109022) ("Jeanne").

Claim 1 is directed to a cooling composition comprising one or more substances having a melting point or melting interval between 28 C and 40 C and a positive melting

Art Unit: 1617

enthalpy, wherein the one or more substances are present in the preparation in the solid state. The phrase "cosmetic or medicinal topical" is a preamble which denotes an intended future use of the composition, and thus no patentable weight is given to the term.

Jeanne discloses a non-insecticidal insect repellent composition comprising methyl pyristate, methyl palmitate or butyl palmitate or combinations thereof. See abstract. The reference teaches that the active ingredients is present in the range of 1-40 volume percent either in a liquid or solid carrier. See col. 4, lines 56 - 61. The reference teaches that the active ingredients may be suspended in liquid carrier, which indicates that the actives in the form of solid state. See col. 5, lines 18-22. The reference also teaches an ointment carrier which is suitable to apply to skin, hair, and clothing. See col. 4, line 63 – col. 5, line 9. See instant claim 5.

Jeanne does not explicitly teach that the composition has a cooling effect, however, the present claims are anticipated because a chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Since the Jeanne insect repellent comprises the same solid active agents as claimed by applicants, the prior art inherently possesses cooling property.

The method of cooling skin with the Jeanne composition is inherently practiced every time the prior art composition is used as intended, since it meets all the limitations of the claimed composition of instant claim 12. When the prior art device is the same as

Art Unit: 1617

a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. See In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986).

Claims 1-6 and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kauffmann (US 5674504).

Kauffmann discloses a cosmetic aqueous gel comprising spheroids of triglycerides having fusion zone of 36-38 °C. See col. 5, lines 15-63; col. 6, line 53 – col. 38. See instant claims 1, 5, 6, 12, 14-16. The fusion zone is 2-3 °C higher than the melting points of the lipoidal substance, thus the melting point requirement of the instant claims 1 and 12 are met. See also col. 2, lines 37-41. The soothing gel of Example 11 contains the spheroids of example 1 B in amount of 6 % by weight, thus meeting instant claims 2, 3 and 13. The reference teaches that the aqueous gel, when applied to the skin, provides comfort and “freshness” and the spheroids have “soothing” and emollient effect, thus the claimed method of “producing a cooling action on the skin” is considered met. See col. 7, lines 1-4.

Conclusion


No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 7:00AM until 4:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gina Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER